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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,952	01/10/2000	CHARLES I. COOK	USW#1677	3729

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EXAMINER

JUNTIMA, NITTAYA

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 04/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/479,952

Applicant(s)

COOK ET AL.

Examiner

Nittaya Juntima

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-17, and 20-30 is/are rejected.
- 7) ☒ Claim(s) 4,5,18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it does not include date of signature of each inventor.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 16 recites the limitation "the data" in line 2. There is insufficient antecedent basis for this limitation in the claim. The office is treating this limitation as "data."

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 8, 11, 13, 15, 17, 22, 25, and 27, are rejected under 35 U.S.C. 102(b) as being anticipated by Norris et al. (USPN 5,805,587).

Per **claim 1**, as shown in Fig. 1, Norris et al. teaches *generating real-time announcements* (real-time is a relative term and considered here as an alert message indicating

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that a call is waiting is assembled into one or more data packets as soon as the contents of field 250-14 in Fig. 2 are verified by processor 205, col. 6, lines 28-43), **a digital packet-based telecommunications network** (Internet 300), **data** (data messages/packets), **a source** (Internet Access Service, IAS 200), **a destination** (a data terminal, DT1), **data is transferred from a source to a destination** (col. 2, lines 7-20 and col. 3, lines 4-16), **sensing a predetermined trigger event** (processor 205 in Fig. 3 senses a call from station S2 in Fig. 1, col. 5, lines 48-52 and col. 6, lines 16-21 and 28-36), **transmitting a packetized announcement with the data for receipt by the destination upon sensing the predetermined trigger event** (an alert message is inherently transmitted along with Internet data from IAS 200 to DT1 through TS 105 and CO 25 for receipt by DT1 while the subscriber is busy surfing the Internet, col. 6, lines 16-21 and 28-44), **processing the packetized announcement immediately for receipt by the destination in real-time** (real-time is a relative term and considered here as the call waiting message (the packetized announcement) is decoded as soon as it is received by the modem, col. 8, lines 20-26).

Per **claim 15** is a system claim corresponding to method claim 1, and is rejected for the same reason set forth in rejection of claim 1 with the additions of **an announcement server** (processor 205 in Internet Access Server as shown in Fig. 3), **a packet-based network** (Internet 300, Abstract), and **a processing device** (modem located in DT1, col. 8, lines 20-26).

Per **claims 3 and 17**, Norris et al. does not explicitly teach merging the packetized announcement with the data. However, it is inherent that the packetized announcement (an alert message indicating that a call is waiting) is merged with the Internet data via a B channel of path 150-11 in Fig. 3 as the subscriber is still surfing the Internet and at the same time receiving an

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announcement indicating that a call is waiting to provide the subscriber with call answering options (col. 3, lines 14-15 and 39-41 and col. 6, lines 16-21 and 28-44).

Per **claims 11, 13, 25, and 27**, Norris et al. teaches *the announcement is a visual announcement wherein the visual announcement is a textual announcement* (an alert message indicating that a call is waiting is displayed on terminal DT1, col. 6, lines 44-50 and col. 8, lines 26-31).

Per **claims 8 and 22**, Norris et al. teaches *the announcement is an audible announcement* (a ringing signal, col. 8, lines 26-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 and 20-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris et al. (USPN 5,805,587) in view of Joyce et al. (USPN 6,381,316 B2).

Per **claims 6 and 20**, Norris et al. fail to teach sensing a predetermined amount of time.

Joyce et al. teaches *sensing a predetermined amount of time* (a telephony platform 100 in Fig. 1 with the real-time rating/cutoff function has the ability sense a minimum value threshold (a predetermined amount of time), col. 12, lines 55-67-col. 13, lines 1-12).

Given the teaching of Joyce et al., it would have been obvious to one skilled in the art to incorporate sensing a predetermined amount of time into the method of Norris et al. by including

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the telephony platform 100 of Joyce et al. in the Internet Access Service 200 of Norris et al. to provide customer with pre-paid enhanced communication services, including pre-paid Internet telephony and call waiting functions, and inform customer when account balance is running low (Joyce et al., col. 3, lines 66-67-col. 4, lines 1-3, 35-42, col. 6, lines 16-20, and col. 13, lines 8-12).

Per **claims 7 and 21**, Norris et al. and Joyce et al. fail to explicitly teach generating an announcement identifying an amount of time elapsed. However, Joyce et al. teaches the real-time rating/cutoff function, informing customer of his/her maximum allowable calling time, and generating warnings and account-balance announcements (col. 12, lines 55-67-col. 13, lines 12). Therefore, it is inherent that warning and an account-balance announcement (an announcement) identify and reflect calling time elapsed (an amount of time elapsed) to inform a customer when a minimum value threshold approaches.

Claims 2, 9-10, 12, 14, 16, 23-24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris et al. (USPN 5,805,587).

Per **claims 2 and 16**, Norris et al. fails to teach suspending processing of data until the packetized announcement has been processed. However, it would have been obvious to one skilled in the art to suspend processing of data until the packetized announcement has been processed as, for example, in a case of TDMA where a time slot is used, the processor would process the packetized announcement first while holding or suspending processing of data if the packetized announcement is received in the time slot to be processed before the data.

Per **claims 9-10 and 23-24**, Norris et al. fails to teach that the announcement is a pre-recorded voice announcement and a synthesized announcement. However, it would have been

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obvious to one skilled in the art to also include a pre-recorded voice announcement and a synthesized announcement as available options for an alert message indicating that a call is waiting of Norris et al. in order to get subscriber's attention and provide him/her with feel and sound of human-operator.

Per **claims 12 and 26**, Norris et al. fails to teach that the visual announcement is a graphical announcement. However, it would have been obvious to one skilled in the art to include a graphical announcement as available option for an alert message indicating that a call is waiting of Norris et al. to get subscriber's attention.

Per **claims 14 and 28**, Norris et al. fails to teach that the announcement is a vibratory signal. However, it would have been obvious to one skilled in the art to include a vibratory signal as available option for an alert message indicating that a call is waiting of Norris et al. by causing the display DT1 screen to vibrate to get subscriber's attention.

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris et al. (USPN 5,805,587) in view of Gibbs et al. (USPN 6,278,706 B1).

Per **claims 29 and 30**, Norris et al. fails to teach the processing device is a wireless handset which is a component of a wireless network. Gibbs et al. teaches using a wireless handset (a hand held device) which is a component of a wireless network to connect to a packet network using Internet Protocol and process data packets (Figs. 1 and 2, and col. 3, lines 32-66).

Given the teaching of Gibbs et al., it would have been obvious to one skilled in the art to modify the system of Norris et al. and include a wireless handset which is a component of a wireless network into the system of Norris et al. to also enable wireless subscribers to receive an announcement (e.g. an alert message indicating that a call is waiting) while surfing the Internet.

Allowable Subject Matter

5. Claims 4-5 and 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

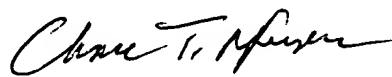
- Liu et al. (USPN 6,392,999 B1), disclosing generating tone and announcement for wireless VoIP and VoATM calls.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 703-306-4821. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9408 for regular communications and 703-827-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nittaya Juntima
March 31, 2003
NJ


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